

**REMARKS**

**I. Improper Finality of the Office Action**

Applicants submit that the finality of the outstanding Office Action dated September 2, 2008, was improper.

M.P.E.P. § 706.07(a) indicates that a second action on the merits should not be final

where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. § 1.97(c) with the fee set forth 37 C.F.R. § 1.17(p).

The outstanding Office Action was the second action on merits, and it introduced a new ground of rejection of claims 1-14, 16-27, and 33-44 under 35 U.S.C. § 101 for the first time. The new ground of rejection, however, was neither necessitated by Applicants' amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. § 1.97(c). Consequently, the finality of this outstanding Office Action unfairly and prematurely precludes Applicants' opportunity to fully respond to the new grounds of rejection.

The outstanding Office Action asserts that "[t]he independent claim is directed towards steps of 'providing,' 'broadcasting,' 'encouraging,' and 'enabling,' [and] these claims [purportedly] fall within the scope of human intelligence alone, and are [purportedly] non-statutory." Office Action at 3. Applicants submit that the steps of "providing," "broadcasting," "encouraging," and "enabling" were recited in the original application, and thus were not introduced by Applicants' amendment of the claims submitted in response to the first non-final Office Action. No information disclosure

statement was filed during the period set forth in 37 C.F.R. § 1.97(c). Therefore, according to M.P.E.P. § 706.07(a), the outstanding Office Action does not meet the criteria for making the action final.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the finality of the outstanding Office Action.

## **II. Regarding Office Action**

In the outstanding Office Action, the following actions were taken:

- a) claims 1-14, 16-27, and 33-44 were rejected under 35 U.S.C. § 101;
- b) claims 1, 10, 11, 14, 16, 17, 21, 25, 26, 33, 40, and 42-44 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0018969 of Humpleman et al. ("Humpleman") in view of Las Vegas, Nevada, Hosts Infomercial Awards Conference, October 2, 2002, by Mark Albright, Knight-Ridder/Tribune Business News, pages 1-4 ("Albright"), and further in view of U.S. Patent No. 6,915,271 ("Meyer");
- c) claims 2-6, 18, 27, 34-38, and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Humpleman and Albright, in view of Meyer, and further in view of Skin Care and Acne Treatment Products from Proactiv Solution Infomercial by Guthy-Renker (2001, 2002) ("Guthy-Renker");
- d) claims 7, 8, and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Humpleman and Albright, in view of Meyer, and further in view of Total Gym Infomercial by Engineering Fitness International Inc. (1996-2001) ("EFI");
- e) claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Humpleman, Albright, in view of Meyer, in view of EFI, and further in view of Examiner's Official Notice;
- f) claims 12 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Humpleman and Albright, in view of Meyer, and further in view of U.S. Patent No. 6,735,572 to Landesmann ("Landesmann");

- g) claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Humpleman, Albright, in view of Meyer, and in view of Guthy-Renker, and further in view of U.S. Patent No. 5,335,679 to Baxter ("Baxter");
- h) claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Humpleman, Albright, in view of Meyer, in view of Guthy-Renker, in view of Baxter, and further in view of U.S. Patent No. 6,770,103 to Patel et al. ("Patel");
- i) claims 22 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Humpleman and Albright, and in view of Meyer, and further in view of U.S. Patent No. 6,443,840 to Von Kohorn ("Von Kohorn"); and
- j) claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Humpleman and Albright, in view of Meyer and further in view of U.S. Patent No. 7,006,983 to Packes, Jr. et al. ("Packes").

By this reply, Applicants have amended claims 1, 2, 8, 9, 11-13, 25, 26, 33-38, 40, and 41, added new claims 45-48, and canceled claims 7, 39, 42, and 43 without prejudice or disclaimer. Support for the amendments can be found in the specification at, for example, ¶¶40-42. Support for the new claims can be found in the specification at, for example, ¶¶35, 40-42, and 55. Claim 15 was canceled in a previous amendment, without prejudice or disclaimer. Claims 1-6, 8-14, 16-38, 40, 41, and 44-48 are currently pending, with claims 1 and 33 being independent. Claims 28-32 have been withdrawn from consideration as being non-elected. Based on the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and withdrawal of the rejections.

**A. § 101 Rejection of Claims 1-14, 16-27, and 33-44**

Claims 1-14, 16-27, and 33-44 were rejected under 35 U.S.C. § 101 because the claimed invention is purportedly directed to non-statutory subject matter. Although

Applicants respectfully disagree, Applicants, in an effort to advance prosecution, have amended claims 1 and 33. In a recent Federal Circuit decision, the court stated that “an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article.” *In re Bilski*, slip op. at 24. Amended independent claim 1 recites “[a] processor-implemented method of marketing a mass consumer product over a broadcast network . . . comprising [among other things] broadcasting over a broadcast network . . . .” Applicants submit that amended independent claim 1 is tied to a particular machine, and thus conforms with the Federal Circuit decision in *In re Bilski*.

Claim 33 recites “[a] system for marketing a mass consumer product over a broadcast network comprising [among other things] a broadcast component for broadcasting over a broadcast network . . . .” Applicants submit that claim 33 is directed to statutory subject matter, and not directed to a program per se.

Claims 2-6, 8-14, 16-27, and 44 depend from amended independent claim 1, and claims 34-38, 40, and 41 depend from amended independent claim 33. Claims 2-6, 8-14, 16-27, 34-38, 40, 41, and 44 are therefore also directed to statutory subject matter.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 101 rejection of claims 1-6, 8-14, 16-27, 33-38, 40, 41, and 44.

**B. § 103(a) Rejection of Claims 1, 10, 11, 14, 16, 17, 21, 25, 26, 33, 40, and 42-44 Based on Humpleman, Albright, and Meyer**

Applicants respectfully traverse the § 103(a) rejection of claims 1, 10, 11, 14, 16, 17, 21, 25, 26, 33, 40, and 42-44 under 35 U.S.C. § 103(a) as being unpatentable over

Humpleman in view Albright, and further in view of Meyer. A *prima facie* case of obviousness has not been established with respect to claims 1, 10, 11, 14, 16, 17, 21, 25, 26, 33, 40, and 42-44.

“The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

**1. Claim 1**

Amended independent claim 1 recites, among other things, “customizing the incentive based on the obtained personal information such that the incentive relates to purchase of an item suited for an individual having the obtained personal information.” The cited references fail to teach or suggest the recited subject matter.

Humpleman is directed to “method and system for interactive television services with targeted advertisement delivery and user redemption of delivered value.”

Humpleman, Abstract. As targeted advertisement delivery, Humpleman discloses that “[o]nly those viewers who closely match the targeting parameters of this promotion will receive the offer.” Humpleman at ¶59. Humpleman, however, does not teach or suggest “customizing the incentive based on the obtained personal information such that the incentive relates to purchase of an item suited for an individual having the obtained personal information,” as recited in amended independent claim 1. Instead, in Humpleman, a viewer is either qualified (closely matched) or unqualified to receive the offer. The offer in Humpleman is not customized in any way such that the offer relates to purchase of an item suited for an individual having personal information that is obtained from consumers.

Albright does not cure these deficiencies of Humpleman, and the outstanding Office Action does not allege otherwise as Albright is relied upon only for its alleged teachings of “broadcasting a program of at least about 10 minutes in duration, the program containing information about the mass consumer product.” Office Action at 4-5.

Meyer does not cure these deficiencies of Humpleman and Albright. Meyer is directed to a “method and system for delivering redeeming dynamically and adaptively characterized promotional incentives on a computer network.” Meyer, Abstract. Meyer discloses that “[o]ne or more parameters of the incentives may be dynamically determined by being dependent on one or more characteristics of the consumer including the location on the network where the incentive is being viewed.” Id. Meyer discloses dynamically determining the discount percentage/amount (FIGS. 25 and 26), and other incentive characteristics such as whether the incentive is negotiable (FIGS. 26 and 28). Nowhere does Meyer, however, teach or suggest customizing that provides an incentive relating to purchase of an item suited for an individual having personal information obtained from consumers. Thus, Meyer fails to teach or suggest “customizing the incentive based on the obtained personal information such that the incentive relates to purchase of an item suited for an individual having the obtained personal information,” as recited in amended independent claim 1.

In view of the above-noted deficiencies of the cited references, and the lack of any legitimate reason for one of ordinary skill in the art to modify the teachings of the references to achieve the claimed combination, there is no *prima facie* case of obviousness with respect to claim 1. Accordingly, the rejection of claim 1 under 35 U.S.C. § 103(a) should be withdrawn.

**2. Claim 33**

Amended independent claim 33, although of different scope, recites features that are similar to the features recited in amended independent claim 1. For example, amended independent claim 33 recites, among other things, “an incentive component for customizing the incentive based on the obtained personal information such that the incentive relates to purchase of an item suited for an individual having the obtained personal information.”

As explained above with respect to amended independent claim 1, Humpleman, Albright, and Meyer, taken alone or in combination, fail to teach or suggest “customizing the incentive based on the obtained personal information such that the incentive relates to purchase of an item suited for an individual having the obtained personal information,” as recited in amended independent claim 1.

For at least reasons similar to the reasons set forth with respect to amended independent claim 1, a *prima facie* case of obviousness has not been established with respect to amended independent claim 33. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of amended independent claim 33 based on Humpleman, Albright, and Meyer.

**3. Claims 10, 11, 14, 16, 17, 21, 25, 26, 40, and 44**

Claims 10, 11, 14, 16, 17, 21, 25, 26, and 44 depend from amended independent claim 1, and claim 40 depends from amended independent claim 33. Thus, the dependent claims are allowable at least by virtue of their dependence from an allowable independent claim. Accordingly, Applicants respectfully request reconsideration and



withdrawal of the § 103(a) rejection of claims 10, 11, 14, 16, 17, 21, 25, 26, 40, and 44 based on Humpleman, Albright, and Meyer.

**C. § 103(a) Rejection of Claims 2-6, 18, 27, 34-38, and 41 Based on Humpleman, Albright, Meyer, and Guthy-Renker**

Claims 2-6, 18, and 27 depend from amended independent claim 1, and claims 34-38 and 41 depend from amended independent claim 33. As explained above with respect to amended independent claims 1 and 33, Humpleman, Albright, and Meyer, taken alone or in combination, fail to teach or suggest “customizing the incentive based on the obtained personal information such that the incentive relates to purchase of an item suited for an individual having the obtained personal information,” as recited in amended independent claim 1, and similarly in amended independent claim 33.

Guthy-Renker fails to cure these deficiencies of Humpleman, Albright, and Meyer, and the outstanding Office Action does not allege otherwise as Guthy-Renker is relied upon only for its alleged teachings related to demonstrating a product during broadcasting of a program and alleged teachings that the product is at least one of a personal care product and a cosmetic product. Office Action at 12-20. For at least these reasons, the cited references do not support the § 103(a) rejection of claims 2-6, 18, 27, 34-38, and 41. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claims 2-6, 18, 27, 34-38, and 41 based on Humpleman, Albright, Meyer, and Guthy-Renker.

**D. § 103(a) Rejection of Claims 7, 8, and 39 Based on Humpleman, Albright, Meyer, and EFI**

Claim 8 depends from amended independent claim 1. As explained above with respect to amended independent claim 1, Humpleman, Albright, and Meyer, taken alone

or in combination, fail to teach or suggest “customizing the incentive based on the obtained personal information such that the incentive relates to purchase of an item suited for an individual having the obtained personal information,” as recited in amended independent claim 1.

EFI fails to cure these deficiencies of Humpleman, Albright, and Meyer, and the outstanding Office Action does not allege otherwise as EFI is relied upon only for its alleged teachings of having contact information for consumers to use to request an incentive. Office Action at 20-22. For at least these reasons, the cited references do not support the § 103(a) rejection of claim 8. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claim 8 based on Humpleman, Albright, Meyer, and EFI.

**E. § 103(a) Rejection of Claim 9 Based on Humpleman, Albright, Meyer, EFI, and the Examiner’s Official Notice**

Claim 9 depends from claim 1. As explained above with respect to claim 1, Humpleman, Albright, and Meyer, taken alone or in combination, fail to teach or suggest “customizing the incentive based on the obtained personal information such that the incentive relates to purchase of an item suited for an individual having the obtained personal information,” as recited in amended independent claim 1. As explained above with respect to claim 8, EFI fails to cure the deficiencies of Humpleman, Albright, and Meyer.

The Examiner’s Official Notice, which Applicants respectfully dispute, fails to cure these deficiencies of Humpleman, Albright, Meyer, and EFI, as the Examiner’s Official Notice alleges that “it is [purportedly] old and well known in the art to encourage

consumers several times during a television program or infomercial of incentives.”

Office Action at 22-23. For at least these reasons, the cited references and the Examiner’s Official Notice do not support the § 103(a) rejection of claim 9. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claim 9 based on Humpleman, Albright, Meyer, EFI, and the Examiner’s Official Notice.

**F. § 103(a) Rejection of Claims 12 and 13 Based on Humpleman, Albright, Meyer, and Landesmann**

Claims 12 and 13 depend from amended independent claim 1. As explained above with respect to amended independent claim 1, Humpleman, Albright, and Meyer, taken alone or in combination, fail to teach or suggest “customizing the incentive based on the obtained personal information such that the incentive relates to purchase of an item suited for an individual having the obtained personal information,” as recited in amended independent claim 1.

Landesmann fails to cure the deficiencies of Humpleman, Albright, and Meyer, and the outstanding Office Action does not allege otherwise as Landesmann is relied upon only for its alleged teachings of “buyer-driven targeting of purchasing entities having the means to allow consumers to request other information during the request for the incentive” and “buyer-driven targeting of purchasing entities having information that includes a list of retail establishments that carry the product and are in geographical proximity to respective locations of the consumers.” Office Action at 23-24. For at least these reasons, the cited references do not support the § 103(a) rejection of claims 12 and 13. Accordingly, Applicants respectfully request reconsideration and withdrawal of

the § 103(a) rejection of claims 12 and 13 based on Humpleman, Albright, Meyer, and Landesmann.

Furthermore, the dependent claims recite further distinctions over the cited references. For example, claim 12 recites, among other things, that “further information includes individualized advice related to the mass consumer product and based on the obtained personal information.” The cited references fail to teach or suggest the recited subject matter.

The outstanding Office Action asserts that “Landesmann teaches buyer-driven targeting of purchasing entities having the means to allow consumers to request other information during the request for the incentive.” Office Action at 23 (citing Landesmann, col. 22, lines 12-14). This is incorrect.

Landesmann provides that “with respect to PDA’s that are equipped with a device that pinpoints a consumer’s location, the consumer might receive incentive offers depending on [(1)] his scores, but also depending on [(2)] whether he requests such offers at a particular point in time and [(3)] which stores offering promoted merchandise are in his immediate vicinity when he requests these offers.” Landesmann, col. 22, lines 8-14. Thus, Landesmann simply teaches that a consumer receives an offer depending on (1) his score, (2) when he requests the offer, and (3) where his current location is. Landesmann discloses nothing about “the consumer being able to ask for information on the stores of his immediate vicinity that are offering the promotion,” as asserted by the outstanding Office Action.

Further, even assuming, *arguendo*, that Landesmann discloses “the consumer being able to ask for information on the stores of his immediate vicinity that are offering

the promotion,” Landesmann discloses, at most, further information including information on the stores in his immediate vicinity that are offering the promotion. Thus, Landesmann fails to teach or suggest that “further information includes individualized advice related to the mass consumer product and based on the obtained personal information,” as recited in claim 12.

For these additional reasons, the § 103(a) rejection of claims 12 and 13 based on Humpleman, Albright, Meyer, and Landesmann should be withdrawn.

**G. § 103(a) Rejection of Claim 19 Based on Humpleman, Albright, Meyer, Guthy-Renker, and Baxter**

Claim 19 depends from claim 18, which depends from amended independent claim 1. As explained above with respect to claim 18, Humpleman, Albright, Meyer, and Guthy-Renker, taken alone or in combination, fail to teach or suggest “customizing the incentive based on the obtained personal information such that the incentive relates to purchase of an item suited for an individual having the obtained personal information,” as recited in amended independent claim 1.

Baxter fails to cure these deficiencies of Humpleman, Albright, Meyer, and Guthy-Renker, and the outstanding Office Action does not allege otherwise as Baxter is relied upon only for its alleged teachings of “a device and process for use in coloring hair having a hair coloring kit for performing a multi-step hair coloring process.” Office Action at 25. For at least these reasons, the cited references do not support the § 103(a) rejection of claim 19. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claim 19 based on Humpleman, Albright, Meyer, Guthy-Renker, and Baxter.

**H. § 103(a) Rejection of Claim 20 Based on Humpleman, Albright, Meyer, Guthy-Renker, Baxter, and Patel**

Claim 20 depends from dependent claim 19, which depends from claim 1. As explained above with respect to claim 19, Humpleman, Albright, Meyer, Guthy-Renker, and Baxter, taken alone or in combination, fail to teach or suggest “customizing the incentive based on the obtained personal information such that the incentive relates to purchase of an item suited for an individual having the obtained personal information,” as recited in amended independent claim 1.

Patel fails to cure these deficiencies of Humpleman, Albright, Meyer, Guthy-Renker, and Baxter, and the Office Action does not allege otherwise as Patel is relied upon only for its alleged teachings of “a method and composition for the gradual permanent coloring of hair compris[ing] a hair coloring kit for performing a multi-step hair coloring process[,] the multi-step hair coloring process compris[ing] applying highlighting material to moist hair and the demonstrating includ[ing] demonstrating the applying of the highlight material to moist hair.” Office Action at 26. For at least these reasons, the cited references do not support the § 103(a) rejection of claim 20. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claim 20 based on Humpleman, Albright, Meyer, Guthy-Renker, Baxter, and Patel.

**I. § 103(a) Rejection of Claims 22 and 24 Based on Humpleman, Albright, Meyer, and Von Kohorn**

Claims 22 and 24 depend from amended independent claim 1. As explained above with respect to amended independent claim 1, Humpleman, Albright, and Meyer, taken alone or in combination, fail to teach or suggest “customizing the incentive based

on the obtained personal information such that the incentive relates to purchase of an item suited for an individual having the obtained personal information,” as recited in amended independent claim 1.

Von Kohorn fails to cure these deficiencies of Humpleman, Albright, and Meyer, and the outstanding Office Action does not allege otherwise as Von Kohorn is relied upon only for its alleged teachings of “evaluation of responses of participatory broadcast audience with prediction of winning contestants; monitoring, checking and controlling of wagering, and automatic crediting and couponing.” Office Action at 27-29. For at least these reasons, the cited references do not support the § 103(a) rejection of claims 22 and 24. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claims 22 and 24 based on Humpleman, Albright, Meyer, and Von Kohorn.

**J. § 103(a) Rejection of Claim 23 Based on Humpleman, Albright, Meyer, and Packes**

Claim 23 depends from amended independent claim 1. As explained above with respect to amended independent claim 1, Humpleman, Albright, and Meyer, taken alone or in combination, fail to teach or suggest “customizing the incentive based on the obtained personal information such that the incentive relates to purchase of an item suited for an individual having the obtained personal information,” as recited in amended independent claim 1.

Packes fails to cure the deficiencies of Humpleman, Albright, and Meyer, and the outstanding Office Action does not allege otherwise as Packes is relied upon only for its alleged teachings of “a method and system for processing a mail-in-rebate certificate.”

Office Action at 29. For at least these reasons, the cited references do not support the § 103(a) rejection of claim 23. Accordingly, Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection of claim 23 based on Humpleman, Albright, Meyer, and Packes.

**K. New Claims 45-48**

New claim 45 depends from amended independent claim 1, and new claims 46-48 depend from amended independent claim 33. Thus, the new claims are allowable at least by virtue of their dependence from an allowable independent claim. Accordingly, Applicants respectfully request allowance of claims 45-48.

**III. Conclusion**

Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

The preceding arguments are based on the arguments presented in the outstanding Office Action, and therefore do not address patentable aspects of the invention that were not addressed in the outstanding Office Action. The pending claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability. Furthermore, the outstanding Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the outstanding Office Action.




Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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By:   
Anthony M. Gutowski  
Reg. No. 38,742